

REMARKS

A. INTRODUCTION

The Office Action has been received and carefully considered. Claims 1-32 are pending in the application. Claims 1, 19 and 24 have been amended. No new matter is added by this Amendment. Applicants believe that the application is now in condition for allowance and notice thereof is respectfully requested.

B. TELEPHONE INTERVIEW

Applicants' representative appreciates the opportunity to have a telephone interview with Examiner Felten on August 24, 2005. The discussion focused on the Examiner's interpretation of claim 1 with respect to the cited reference. Relevant substance of the telephone interview is covered in the following paragraph and Section C below.

During the telephone interview, Examiner Felten also promised to conduct additional searches for any prior art references that might: (1) teach or suggest "formatting an electronic bill summary to be printable as a remittance slip"; or (2) provide motivation to modify the currently cited references to provide this claim element. It is respectfully requested that the Examiner issue an Advisory Action after conducting the prior art searches as promised.

C. THE REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects claims 1-3, 6-9, 17-19, 24-26 and 29-32 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Haseltine et al. (US 6,578,015) in view of Hogan (US 5,699,528). The Office Action also rejects claims 4, 5, 10-16, 20-23, 27 and 28 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Haseltine as modified by Hogan as applied to claim 1 as discussed above, and further in view of Schutzer (US 6,291,789) and Hilt et al (US 5,465,206). These rejections are respectfully traversed as follows.

Applicants' invention, as recited in independent claims 1, 19 and 24, is directed to a system and method for effectuating bill presentment and payment. According to embodiments of the present invention, an electronic bill summary may be formatted in the form of a remittance slip, and an electronic notification containing the electronic bill summary may be transmitted to a payer. Since the electronic bill summary is printable to serve as a remittance slip, the payer is afforded an option between paying the bill electronically or mailing the remittance slip with an payment of the bill.

Haseltine discloses an electronic bill presentment and payment (EBPP) system that is capable of processing bills and payments associated with multiple billers while preserving the billers' corporate identity, as embodied in the "look-and-feel" of the bills presented to customers. The Haseltine system is implemented with a database having three areas, a staging area, an active area, and an archive area, wherein the staging area is for receiving biller-originated bill data and format data, the active area is accessible by the payers to view the bills online and to make electronic payments.

Hogan discloses a bill delivery and payment system in which users are able to access a server computer on a communications network to obtain bill information and pay bills. Using a personal computer, a user can access a Web site provided by the server computer to view the bill information and instruct the server computer as to the details of the bill payment. In a second embodiment, without visiting the web site, users are provided with electronic bills containing bill information in the form of electronic mail (e-mail) at their e-mail addresses. After opening an electronic bill, a user can make the bill payment by replying to the electronic bill.

- (1) The cited references fail to teach or suggest “at least one portion of the electronic summary being formatted in the form of a remittance” or “printable to serve as a remittance slip in a traditional method of payment.”

Individually or in combination, the cited references fail to teach or suggest each and every element recited in the claimed invention. For example, none of the references teaches or even suggests “at least one portion of the electronic summary being formatted in the form of a remittance” or “printable to serve as a remittance slip in a traditional method of payment” as recited in independent claims 1, 19 and 24.

The Office Action admits in page 4 that Haseltine fails to disclose that “the electronic summary can be printed out to serve as a remittance slip in a traditional method of payment ...”

However, the Office Action points to the following passage in Hogan as allegedly disclosing these claim elements:

“The billing data is transmitted from device 150 to server computer 160, via which the subscribers are able to access and “browse” their bills on WWW, and pay the bills using one or more accounts such as credit, checking, and NOW accounts, home equity lines of credit, and any other accounts from which funds may be drawn. The billing data is stored in such a form that the subscribers are allowed to view full graphics of their bills on PC's, print the bills on printers connected thereto, and download them for storage. Payment transactions are routed from server computer 160 to another network or system such as MasterCard's Banknet, MasterCard Debit Switch system or the automated clearing house (ACH) for credit and/or debit authorization. Clearing and settlement of the transactions with the appropriate payees are then performed in a conventional manner.” Hogan, col. 5, lines 1-15 (emphasis added).

It appears that the Examiner was particularly referring to the underlined sentence. It is further stated in the Office Action that “[t]he ability to print text and images from an Internet website that is displayed on a computer screen is notoriously old and well known with the computer networking art.” Therefore, the Office Action asserts that “to modify Haseltine with the ability

to print personal billing information from an Internet website, as taught by Hogan, would be considered an obvious expedient ...”

This finding of obviousness is seriously flawed.

First, the Office Action fails to recognize that, in Hogan, what is printable is a bill, not a remittance slip. In the telephone interview, the Examiner asserted that he considered a remittance slip the same as a bill since, except for different formats, they had the same content or data. However, a remittance slip actually differs from a bill summary not just in format but also in substance. For example, a remittance slip typically includes the payee information (e.g., payable to whom, mailing address etc.), payment instruction for the payer, payer and payment information (e.g., credit or check, actual amount included, customer's change of address and phone number, etc.). A bill summary, which is for a customer's online viewing purpose only, does not and need not provide such information.

Second, the Office Action only focuses on the “printable” aspect but ignored the “formatting” aspect of the claimed invention. Hogan does not teach or suggest formatting a portion of an electronic bill summary in the form of a remittance slip. Since printing of a remittance slip is not provided in Hogan all-electronic system, there is no need to format the bill data for that purpose.

In the description of its system, Hogan makes no reference to a remittance slip at all. In fact, the only instance where the word “remittance” (or “remit”) is used is in the Background of the Invention, where paper checks processing is criticized for entailing significant costs to the payees who receive and handle remittances in this manner. Hogan, col. 1, lines 23-25.

In the telephone interview, the Examiner attempted to support his application of Hogan by offering an example from his own experience. The Examiner stated that, on one occasion, he

misplaced a paper bill therefore could not use the remittance slip attached to the paper bill to make a payment by mail. Instead of requesting another bill, he went online to print out an electronic summary of the bill and used it as a substitute for the original remittance slip. With this example, the Examiner concluded that he was using the same purportedly well known method as claimed in the present invention.

This reasoning is also flawed and does not remedy the deficiency in the cited references.

First, it is unclear whether this incident took place before or after applicants' invention. Nor is it clear whether this individual experience reflects the ordinary level of skill in the art at the time of the present invention.

Second, this example only shows that a bill summary is printable and someone might choose to use it for remittance purposes. It does not show that the step of formatting part of an electronic bill in the form of a remittance slip was ever known or performed. A step of printing out a bill summary to use for remittance purposes does not include the step of formatting bill summary to be printable as a remittance slip.

Third, the fact that individual customers happen to print out a bill summary to use as a remittance slip should not render obvious an invention that explicitly formats a portion of the bill summary to provide a printable remittance slip. For instance, the fact that some people use a rock or a piece of wood or iron to serve the purpose of a hammer should not prevent an inventor from patenting an actual hammer, be it made of rock, wood or iron. Though used for remittance purposes, a bill summary printout is different, in both content and format, from a remittance slip.

In view of the foregoing, it is respectfully submitted that the cited references fail to teach or suggest all the claimed elements.

- (2) All the cited references teach away from “allowing the at least one payer to choose between paying the at least one bill electronically or mailing the remittance slip with an payment of the at least one bill.”

The claimed invention is different from the cited references in that it provides a customer the option to choose between the methods of online electronic payment versus traditional check-and-mail payment. Other EBPP systems, like those in the cited references, are all-electronic and paperless. Therefore, the cited references not only fail to provide a motivation for the modifications or combinations asserted in the Office Action, they actually teach away from “allowing the at least one payer to choose between paying the at least one bill electronically or mailing the remittance slip with an payment of the at least one bill.”

For example, according to Haseltine:

“As may be appreciated, the paper-based bill generation and payment cycle 100 depicted in FIG. 1 is often both a lengthy and costly process.”
Haseltine, col. 1, lines 55-57.

“Such [electronic bill presentment and payment] methods, devices and systems should also allow customers to view and pay such bills without the disadvantages associated with conventional electronic payment systems and/or paper bills and checks.” Haseltine, col. 2, lines 26-29.

“It is believed that implementation of the present invention has several advantages over traditional paper-based bill presentation and payment schemes. Indeed, the present invention reduces the processing and administrative costs of the billers, bill publishers and bill consolidators by foregoing paper in favor of an electronic medium. The present invention also reduces the need for paper-based postage and metering, and reduces the time required for delivery of the bill to its intended recipient. Thanks to the automatic bill payment feature of the present invention, late payments of bills may be reduced, resulting in savings for both billers and customers.” Haseltine, col. 13, lines 41-54.

According to Hogan:

“The most common method of payment of the bills is writing paper checks for the appropriate amounts and mailing such checks to payees. This method is labor intensive and time consuming for a bill-payer, and must be done on multiple occasions each month since the bills do not normally arrive or become due on the same date. In addition, the bill-payer has to

absorb the costs of postage in mailing the paper checks to payees. Paper checks processing also entails significant costs to the payees who receive and handle remittances in this manner.” Hogan, col. 1, lines 15-25

“Advantageously, with this invention, a user is able to electronically receive, review and pay the bills through a series of brief on-line sessions each month.” Hogan, col. 2, lines 60-62.

“The present invention is directed to a technique for delivery of bills over a communications network, and payment of the bills through the network using a personal computer (PC).” Hogan, col. 3, lines 47-50.

According to Schutzer:

“Each bill paid by mail costs the consumer a minimum of postage plus checking charges, and each bill sent by mail costs the biller a minimum of postage plus printing charges. It is estimated that around 19 billion bills per year are sent and paid today, not including many non-bill statements. The use of technology for electronic bill presentment and payment can reduce the cost of the billing and payment process for up to 100 million U.S. households and their vendors and service providers.” Schutzer, col. 1, lines 31-39.

According to Hilt:

“Billers, who often are billing small amounts with each transaction, must incur the costs of processing many checks, including the attendant overhead of dealing with remittance processing, such as opening envelopes, data capture of the consumer's account number, MICR (Magnetic Ink Character Recognition) encoding of the check amounts, etc.” Hilt, col. 1, lines 28-33.

“Given the economies of scale, a biller has great incentive to reduce the cost of remittance processing and, more significantly, the biller has an even larger incentive to reduce the cost of "exception items." An exception item is a payment which, for some reason, cannot be processed according to the highly automated procedures put in place by the biller to quickly process remittances. Exception items include checks received without payment coupons, payment coupons received without checks, checks for amounts different than the amounts shown on the corresponding coupons, multiple payment coupons received in an envelope with a single check. The cost to process a typical payment transaction is \$0.09 to \$0.18 per transaction for a high-volume, efficient remittance processing operation, while an exception item transaction might cost as much as \$0.65 to 1.50.” Hilt, col. 1, lines 48-63.

From the quote passages, it is easy to sense a clear aversion towards the traditional paper-based bill payment method. They all strive to avoid the cost associated with the processing of checks and remittances. Given this strong preference for electronic payment, there is no ground for believing that the cited references provide any suggestion or motivation for a modification that would give a payer an option to choose the traditional paper-based payment over the electronic payment.

Since the cited references do not (1) teach or suggest all the claim elements or (2) provide the requisite motivation for modification or combination, the Office Action has failed to establish a *prima facie* case of obviousness. Therefore, independent claims 1, 19 and 24 as well as their dependent claims are all patentable over the cited references.

Withdrawal of the obviousness rejections is respectfully requested.

D. CONCLUSION

For at least the reasons provided above, Applicants respectfully submit that the application is in condition for allowance. Favorable reconsideration and allowance of the pending claims are respectfully solicited.


Should there be anything further required to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below before issuance of any further office action.

In the event any additional fees are due, the Commissioner is hereby authorized to charge the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

HUNTON & WILLIAMS, LLP

By:



Ce Li

Registration No. L0214

Hunton & Williams, LLP
1900 K Street, N.W., Suite 1200
Washington, D.C. 20006-1109
Telephone (202) 955-1500
Facsimile (202) 778-2201

Dated: 9/13/2005